

ESTTA Tracking number: **ESTTA115160**

Filing date: **12/18/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91173800
Party	Defendant Sterling Bank and Trust, FSB Sterling Bank and Trust, FSB One Towne Square 17th Floor , MI 48076
Correspondence Address	MICHAEL B. STEWART RADER FISHMAN & GRAUER PLLC 39533 WOODWARD AVE, STE 140 BLOOMFIELD HILLS, MI 48304 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Michelle L. Visser
Filer's e-mail	interpartesparalegals@raderfishman.com
Signature	/Michelle L. Visser/
Date	12/18/2006
Attachments	Motion to Suspend.pdf (3 pages)(149380 bytes) Request for Amendment.pdf (3 pages)(77369 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

STERLING BANK,)	
)	
Opposer,)	
)	Opposition No. 91173800
v.)	Application Serial No. 75/936,977
)	STERLINGBANK.COM
STERLING BANK & TRUST FSB,)	
)	
Applicant)	
)	
)	
)	
	/	

**MOTION TO SUSPEND PROCEEDING FOR GOOD CAUSE PURSUANT TO
37 C.F.R. §2.117(C) AND TBMP § 510, AND BRIEF IN SUPPORT OF MOTION**

Pursuant to 37 C.F.R. §2.117(c) and TBMP § 510, Applicant, Sterling Bank & Trust FSB (“Applicant”) motions the Board to suspend the instant proceeding for good cause, pending the Examining Attorney’s decision on Applicant’s request to amend the mark in Application Serial No. 75/936,977 filed October 13, 2006.

I. INTRODUCTION

On **September 26, 2006**, Opposer requested, and was granted, a 90 day extension of time to oppose Application Serial No 75/936,977. On **November 6, 2006**, Opposer filed a Notice of Opposition against Application Serial No. 75/936,977. The opposition was instituted on **November 7, 2006**. However, on **October 13, 2006**, after the request for extension of time to oppose was filed, but before the Notice of Opposition was filed, Applicant filed a request to amend the mark in Application Serial No. 75/936,977 from STERLINGBANK.COM to STERLING BANK. A copy of such request for amendment from the Office’s TDR system, evidencing receipt of such request on October 13, 2006, is attached to the instant motion and brief in support thereof.

II. GOOD CAUSE FOR SUSPENSION OF THE PROCEEDING EXISTS.

TBMP § 510.01 provides that “[f]ollowing from the Board’s inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board.” TBMP § 510.03(a) further notes that “[p]roceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board.”

TBMP § 212 provides:

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as a request for republication, a request for reconsideration of a refusal to approve an amendment) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the examining attorney who must determine the propriety of the amendment or other paper.”

TBMP § 212 also states:

Any amendment proposed by an applicant, whether of its own volition or to accommodate a concern of a potential opposer must be sent to the Board’s attention, not to the examining attorney who approved the mark for publication. The Board will note the amendment and transfer the file to the examining attorney.

However, Applicant’s counsel understands from discussions with Board personnel regarding previous requests for amendment filed during the opposition period, after requests for extension of time to oppose had been filed, that there was an informal rule change at the Trademark Trial and Appeal Board, and that requests for amendment should actually be forwarded directly to the examining attorney’s attention. For this reason, Applicant submitted the request directly to Law Office 113, to the Examining Attorney’s attention.

TBMP § 212.04 notes that “[i]f an amendment is filed prior to the Board’s institution of a timely opposition, the Board will institute the opposition, and at the same time suspend the opposition pending consideration of the amendment by the examining attorney.”

Applicant has reason to believe that the Examining Attorney will likely grant Applicant’s request for amendment of its mark from STERLINGBANK.COM to STERLING BANK. Moreover, enabling

Applicant to wait until after the mark is amended to answer the Notice of Opposition will enable Applicant to answer as to the mark that is actually the subject of the opposition proceeding.

For the foregoing reasons, Applicant submits that it has demonstrated good cause for the suspension of the proceeding, pending consideration of the request for amendment by the Examining Attorney.

III. CONCLUSION

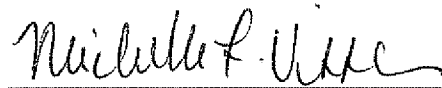
For the reasons described herein, Applicant requests that the motion to suspend be granted.

Respectfully submitted,

RADER, FISHMAN & GRAUER PLLC

Date: December 18, 2006

By:



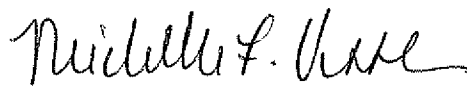
Michael B. Stewart
Michelle L. Visser
39533 Woodward Avenue, Suite 140
Bloomfield Hills, Michigan 48304
248-594-0600 (tel)
248-594-0610 (fax)
interpartesparalegals@raderfishman.com
PTO Customer No. 010291

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing *Motion to Suspend Proceeding for Good Cause pursuant to 37 C.F.R. §2.117(c) and TBMP § 510, and Brief in Support of Motion* is being deposited with the United States Postal Service as First Class mail, postage prepaid, in an envelope addressed to:

Roberta Jacobs-Meadway
Ballard Spahr Andrews and Ingersoll, LLP
1735 Market Street, 51st Floor
Philadelphia, PA 19103

Date: December 18, 2006



Michelle L. Visser

R0391336

RADER,**FISHMAN****& GRAUER****PLLC**

*Worldwide Intellectual Property Matters • Patents • Trademarks
Litigation • Copyrights • U.S. and Foreign Portfolio Management
Computer and Internet Law • Trade Secrets • Unfair Competition*

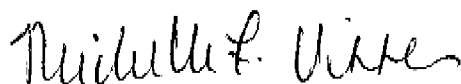
To: Stacy B. Wahlberg, Law Office 113**From:** Michelle Visser (248-594-0644 direct dial)**Fax:** 571-273-9113**Pages:** 2 + Coversheet**Phone:** 571-272-9441**Date:** October 13, 2006**Re:** Application Serial No. 75/936,977 for STERLINGBANK.COM by Sterling Bank & Trust FSB

This facsimile is intended only for the use of the individual or entity to which it is addressed and may contain information that is privileged, confidential, and exempt from disclosure under applicable laws. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, you are hereby notified that any dissemination, distribution, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us immediately by telephone or fax, and return the original message to us at the above address via U.S. Postal Service. Thank you.

Ms. Wahlberg,


We understand that the proper procedure (despite what the Trademark Board Manual of Procedure states) for requests to amend applications that have been published for opposition and for which request(s) for extension of time to oppose have been filed, but no opposition has been filed, is to submit the request for amendment to the appropriate law office, to the examining attorney's attention.

Please find attached a request to amend the mark in the above-referenced application. If you have any questions, please do not hesitate to contact us. Thank you for your assistance in this matter.



Michelle Visser

I hereby certify, pursuant to 37 C.F.R. §§ 1.8 and 1.6(d), that this correspondence is being transmitted via facsimile to Law Office 113, to 571-273-9113, on October 13, 2006, by Michelle L. Visser



R0338745

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Sterling Bank & Trust FSB		
Mark:	STERLINGBANK.COM		
Serial No.	75/936,977	Law Office:	113
Filed:	March 6, 2000	Int'l Classes:	36
Publication Date:	September 19, 2006	Docket No.	65006-0028

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

REQUEST FOR AMENDMENT PURSUANT TO TMEP § 1505.02(C)

Pursuant to TBMP §§ 212.01 and 212.03, and TMEP § 1505.02(c), Applicant requests that the Office amend the mark in the application from STERLINGBANK.COM to STERLING BANK.

The application was published for opposition on September 19, 2006. A request for extension of time to oppose this application was requested and granted by the Board, extending the opposition period to January 17, 2007. However, Applicant understands that no opposition has been filed.

As TMEP § 1209.03(m) notes, “[p]ortions of the uniform resource locator (URL) including the beginning, (“http://www.”) and the top level Internet domain name (TLD) (e.g., “.com,” “.org,” “.edu,”) function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function.” TMEP § 1215.02(c) echoes this principle, stating:

In viewing a domain name mark (e.g., <http://ABC.COM> or <http://WWW.ABC.COM>), consumers look to the second level domain name for source identification, not to the top-level domain (TLD) or the terms “http://www.” or “www.” Therefore, it is usually acceptable to depict only the second level domain name on the drawing page, even if the specimens of use show a mark that includes the TLD or the terms “http://www.” or “www.”

In view of these principles, TMEP § 1215.08 provides that:

Generally, an applicant may add or delete a TLD to/from the drawing of a domain name mark (e.g., COOPER amended to COOPER.COM, or COOPER.COM amended to COOPER) without materially altering the mark. A mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not. However, the public recognizes that a TLD is a universally used part of an Internet address. As a result, the essence of a domain name mark is created by the second level domain name, not the TLD. The commercial impression created by the second-level domain name usually remains the same whether the TLD is present or not.

Therefore, Applicant submits that an amendment of the mark from STERLINGBANK.COM to STERLING BANK is acceptable.

Assuming the Examining Attorney amends the mark STERLINGBANK.COM to STERLING BANK as requested herein, Applicant hereby disclaims the exclusive right to use the term "BANK" apart from the mark as shown.

Please direct any questions regarding this document to the undersigned attorneys for Applicant.

Respectfully submitted,

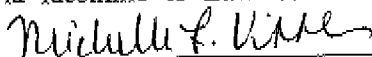
Date: October 13, 2006

By:



Michael B. Stewart
Michelle L. Visser
RADER, FISHMAN & GRAUER PLLC
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304
Telephone: 248-594-0644
PTO Customer Number 010291

I hereby certify, pursuant to 37 C.F.R. §§ 1.8 and 1.6(d), that this correspondence is being transmitted via facsimile to Law Office 113, to 571-273-9113, on October 13, 2006, by Michelle L. Visser



R0338745